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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SUBRAMANIAN, NARAYANSWAMY	
ART UNIT	**PAPER NUMBER**
3691	

MAIL DATE	DELIVERY MODE
11/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/751,331	HEIGES ET AL.	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to applicants' communication filed on August 21, 2007. Amendments to the abstract and claims 1, 2, 5 and 6 have been entered. Objections to the specification and rejections made under 35 USC § 101 are withdrawn in view of the amendments. Claims 1-8 are currently pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 2-4 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 6 recite the limitation "wherein at least one of the educational savings plans is a Section 529 Plan". The limitation specifying a Section 529 renders the claim indefinite. Section 529 is a code, which periodically is updated with changes and therefore makes it transitory-in-nature. Upon each update of the Section 529 code, the scope of the instant application would be altered and would be transitory-in-nature as well. Consequently the Section 529 limitation without a set-in-stone definition renders the metes and bounds of the claim confusing.

Continuing, the specification is a written description of the invention and of the manner and process of making and using the same. The specification must be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention

pertains to make and use the same. See 35 U.S.C. 112 and 37 CFR 1.71. If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See MPEP § 702.01. Referencing Section 529, which is transitory-in-nature, ensures that the scope of the specification is altered with each update of the Section 529 code, and thus the specification is not considered to be full, clear, concise and exact terms as to enable any person skilled in the art to comprehend. Claims 3-4 and 7-8 are rejected for similar reasons and also because they depend on a rejected claim. Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yinbal (US Patent 6,424,952 B1) in view of Crapo (US Patent 5,987,433).

Claims 1 and 5, Yinbal discloses a computerized method and system for analyzing college savings plans, the method for use with a computer-readable medium (See Yinbal Column 9 line 65 – Column 10 line 18, a computer-readable medium is inherent in the disclosure, educational funding and counseling services is interpreted to include college savings plans) on which are stored a plurality of educational institution identifiers and a plurality of educational savings plan parameter sets, each of respective educational institution identifiers being associated

with a corresponding cost parameter set specifying at least one of room, board, and tuition costs for the respective educational institution; each of the plurality of educational savings plan parameters specifying one or more financial characteristics of a corresponding educational savings plan; the method comprising the steps of: a. receiving at least one educational institution identifier (See Yinbal Figure 1, Column 2 line 65 – Column 3 line 46); b. for each of the educational institution identifiers received in step (a), retrieving the corresponding cost parameter set from the computer-readable medium (See Yinbal Figure 1, Column 4 lines 13-65); c. generating a comparative analysis of a plurality of educational savings plans by applying each of the retrieved cost parameter sets of step (b) to each of the plurality of educational savings plan parameters (See Yinbal Figure 1, Column 10 line 61 – Column 11 line 15); and (d) outputting a report of the comparative analysis (See Yinbal Figure 1, Column 9 line 46 – Column 10 line 21).

Yinbal does not explicitly teach the limitation of "the comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans".

Crapo teaches the limitation of the comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans (See Crapo Column 3 lines 15 – 35, Column 4 lines 34-50, Column 5 line 28 – Column 6 line 14).

Both Yinbal and Crapo are concerned with the problem of financial planning for meeting certain financial objectives. It would have been obvious to one of ordinary skill in the art at the time of invention to include the teachings of Crapo to the invention of Yinbal. The combination of disclosures suggested that users would have benefited from using a model that would enable them to achieve their financial objectives (See Crapo Column 2 lines 5-10).

Claims 2-4 and 6-8, Yinbal does not explicitly teach the features wherein at least one of the educational savings plans is a Section 529 Plan; generating a comparative analysis further includes comparing each of a plurality of educational savings plans with reference to one or more specific asset allocations and applying a Section 529 Plan asset allocation to all assets, so as to provide a comparison based upon tax considerations.

Official notice is taken that the features wherein at least one of the educational savings plans is a Section 529 Plan, comparing plans with reference to one or more specific asset allocations and applying tax considerations to asset allocation for all assets are old and well known. These features help parents in making informed decisions about saving for their children's education based on their individual preferences and circumstances.

It would have been obvious to one of ordinary skill in the art at the time of invention to include these features to the invention of Yinbal. The combination of disclosures suggested that parents would have benefited from making informed decisions about saving for their children's education based on their individual preferences and circumstances.

Response to Arguments

6. In response to Applicant's argument "Section 529 plans are well known in the art and are described, in detail, throughout the specification, for example, in the background section. It is noted that other United States patents have issued which refer in their claims to plans developed according to sections of the IRC, such as 401(k) plans, 401(a) plans, 403(b) plans, 457 plans, etc. See, e.g., U.S. Patent Nos.: 7,113,913, 7,155,407, 6,868,389, 6,826,541, and 6,473,737", the examiner would like to respectfully point out that it is well settled that the prosecution of one patent application does not affect the prosecution of an unrelated application. *In re McDaniel,*

293 F3d 1379, 63 USPQ2d 1462, 1468 (Fed. Cir. 2002) citing *In re Wertheim*, 541 F.2d 257, 264, 191 USPQ 90, 97 (CCPA 1976) (holding that "it is immaterial in ex parte prosecution whether the same or similar claims have been allowed to others"). Referencing Section 529, which is transitory-in-nature, ensures that the scope of the specification is altered with each update of the Section 529 code, and thus the specification is not considered to be full, clear, concise and exact terms as to enable any person skilled in the art to comprehend. Hence the rejection under 35 USC § 112, second paragraph is maintained.

Applicant's other arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Sub

Dr. N. Subramanian
Primary Examiner
Art Unit 3691

November 13, 2007